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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,256	12/22/2000	Geoffrey R Morris	282318-00008	5053
3705	7590	11/12/2003	EXAMINER	
ECKERT SEAMANS CHERIN & MELLOTT 600 GRANT STREET 44TH FLOOR PITTSBURGH, PA 15219			FORD, JOHN K	
			ART UNIT	PAPER NUMBER
			3753	

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/674,256

Applicant(s)

Mou's

Examiner

FORD

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 3/14/03
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-59, 10, 12, 14-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-59, 10, 12, 14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 3/14/2003 a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Applicant's response of March 14, 2003 (Paper No. 8) has been given careful consideration. Applicant makes equivocal comments regarding the invention such as: it "may be used as a roofing panel" (emphasis supplied). Similarly the external passageways "can" contain a gas or "can contain another liquid" according to applicant's remarks. Finally, the heat exchange assembly "can be of any suitable shape and configuration consistent with the above" (emphasis supplied). "Any suitable shape and configuration consistent with the above" need not necessarily be flat in the Examiner's understanding of Applicant's remarks.

Applicant argues Saperstein et al Figures 6-8 is not equivalent to a "flat panel". There is no limitation in any of the claims that calls for a "flat panel". Many panels in this art are not flat as evidenced by DT 2543326 (cited here solely for the purpose of rebutting the line of argument that a "panel" is synonymous in this art with a "flat panel" in the heat exchange art). If you need to rely on a limitation to distinguish from the prior art (such as "flat", here) then it must appear in the claim to be given weight. The word "flat" does not appear in any of the claims currently being rejected. Moreover, in claims 1-5, 9 and 10 there is no "panel" claimed let alone a flat panel. Amended claim 1 recites at least one manifold not only one manifold as argued. Saperstein shows two manifolds 106, 108 that communicate with passages 128 and 124 and manifolds 102, 104 that communicates with passages 116. Applicant's arguments are simply incommensurate with the scope of the claims.

It is also noted that in the International search report to PCT/AU 99/00320 (published as WO 99/55984), Examiner Bagusauskas, cited AU 68020/98 (corresponding to AU 696305) as an "X" reference (meaning a 35 USC 102(b)) against all of the claims 1-16. In the IDS prepared by applicant filed October 26, 2000, applicant did not provide this document to the Examiner. It clearly should have been provided pursuant to Rule 56, and, if the reference is what Examiner Bagusauskas describes it to be, it is fatal to this application. It must be provided in response to this office action and is considered overdue at this point. No amendment after final or request for reconsideration will be considered until AU 696305 published September 3, 1998 is made of record.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 9, 10, 12 and 14-16 are rejected under 35 USC 102(b) as anticipated by AU 696305 (corresponding to AU 68020/98) published September 3, 1998.

According to Examiner Bagusauskas' analysis, Applicant failed to claim priority in PCT/AU99/00320 back to the earliest priority document that disclosed the claimed invention (apparently because more than a year had gone by) and hence the priority claim in Applicant's PCT filing (to Australian PP 3292 04/29/1998) fails (for not claiming the earliest priority document) and the current application (as well as the PCT application from which it derives) is therefore entitled to April 28, 1999 (the date PCT/AU99/00320 was filed) as its earliest effective filing date. See MPEP 201.13 F. "First Foreign Application" and corresponding sections of the Patent Cooperation Treaty. The publication of AU 696305 on September 3, 1998 predates applicant's earliest effective filing date of April 28, 1999.

Claims 1-5, 12 and 14-16 are rejected under 35 USC 102(b) as anticipated by or, in the alternative under 35 USC 103(a) as obvious over Saperstein et al. (Figures 6-8).

Claims 1-4 only claim a heat exchange assembly with at least one manifold. Note in Figure 7 manifold 106 is coupled to the external sheets (at the right hand side of the Figure) and the internal sheets (in the vicinity of manifold 102) at the right hand side of manifold 106. The internal and external passageways communicate with at least one manifold (106 and 102) as claimed. Claim 5 adds the "panel" recitation and claims 12 and 14-16 add the "roofing panel" limitation to the preamble of claims 12 and 14-16 and the word "panel" to the body of claim 12 and as demonstrated above a "panel" in the heat exchanger art need not be flat and claims 5, 14 and 14-16 do not claim a flat panel.

Regarding intended fluids specified in claims 3 and 4, applicant states in his remarks that they can contain another liquid aside from the claimed air.

Moreover, regarding claims 3 and 4, intended fluids do not impart patentability to an otherwise known device. See Ex parte Masham, 2 USPQ2d 1647 (BPAI 1987) and the cases cited therein.

Finally, regarding the "panel" limitation found in claim 5, Saperstein exists in a flattened state (which it inherently possesses by virtue of its being an extrusion) prior to bending it into its final coil shape. If necessary it is that "flat" configuration that the

Examiner relies upon, for claims reciting a "panel". The term "roofing panel" denotes an intended final use for the claimed apparatus and is not a structural limitation. See MPEP 2114.

Claims 1-5, 12 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saperstein as applied to claims 1-5, 12 and 14-16 above, and further in view of JP 61-202084.

JP '084 teaches an integral header (5,6) in Figure 2 for a layered panel-type tube. To have formed the headers (106, 102) of Saperstein in the manner taught by JP '084 (rectangular with a shared wall) would also have been obvious from the teaching of JP '084. Regarding claim 15 process of making recitations (i.e. extrusion) in a claim drawn to apparatus are not given patentable weight. Alternatively, extrusion is a well known inexpensive process of forming metal of which official notice is taken.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saperstein or Saperstein/JP '084 as applied to claims 1-5, 12 and 14-16 above, and further in view of Kennon.

Kennon teaches a pressure relief means that is a riser positioned in one of the fluid inlet and/or outlet means. To have provided Saperstein or Saperstein/JP '084 with such a pressure relief means to prevent an explosion in a heat exchange application where significant pressure build-up was possible (e.g. in a closed system which was

being heated or pressurized) would have been obvious to one of ordinary skill to avoid the potentially catastrophic consequences of an explosion.

Applicant's amendment necessitated the new ground (s) of rejection presented in this office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07 (a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to John K. Ford at telephone number 703-308-2636.



**John K. Ford**  
**Primary Examiner**